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As will be explained below, it is believed that the claims were patentable over the cited art in their original form and, therefore, the claims have not been amended to overcome the reference.

Claim 10, has, however, been changed solely for reasons of clarity, as the roller in the claim is a liquid carrying roller. See, i.e., page 5, lines 4 to 13, of the specification of the instant application. The changes are not provided for overcoming the cited prior art and are not intended to narrow the scope of the claim for any reason related to the statutory requirements for a patent.

Before discussing the prior art in detail, it is believed that a brief review of the invention as claimed, would be helpful. Claim 1 calls for, *inter alia*, a rotatable body for printing machines, the rotatable body including:

a circumferential surface provided with a surface structure and formed of a nonmetallic material, the circumferential surface being a roller selected from the group of rollers consisting of a slip roller and a vibrator roller.

Similarly, claim 10 calls for, *inter alia*, a printing machine comprising:

at least one roller with a circumferential surface provided with a surface structure and formed of a nonmetallic material, the circumferential surface carrying a liquid, and the roller being selected from the group of rollers consisting of a slip roller and a vibrator roller.

The Examiner refers to two rollers mentioned in Guaraldi, specifically, a slip roller 16 and a vibrator roller 20. Conventionally, a "vibrator roller" is also a roller that periodically comes into contact with another roller (see, i.e., page 5, line 24, to page 6, line 19, as well as page 8, lines 22 to 24, of the specification of the instant application). Therefore, one having ordinary skill in the art would know that Guaraldi vibrator roller 20 is incorrectly labeled, and that person skilled in the art would commonly, and correctly, use the term "distributor roller" for the Guaraldi roller 20.

Due to this clarification and correction, one having ordinary skill in the art would know that the incorrectly labeled vibrator roller 20 in Guaraldi cannot be compared to the vibrator roller mentioned in claims 1 and 10 of the instant application. As such, the conclusion equating the vibrator

roller of the instant application with the Guaraldi roller 20 is incorrect.

Therefore, the following arguments are directed to the comparison between the slip roller 16 in Guaraldi and the slip roller in the claims 1 and 10 of the instant application.

Even though Guaraldi discloses that the circumferential surface of the slip roller 16 is made of rubber and, thus, from a non-metallic material (see col. 3, lines 52 to 54, therein), nowhere does Guaraldi suggest, let alone disclose, providing the surface structure on the circumferential surface as set forth in claims 1 and 10 of the instant application.

Further, Guaraldi does not teach towards providing such a surface structure. Due to the fact that Guaraldi contains no information regarding the structuring or non-structuring of the roller circumferential surface, and, in light of the fact that Guaraldi provides that the "outer surface of the slip roller 15 as is conventional is made of a rubber material," one having ordinary skill in the art would be directed towards providing a conventional embodiment of the slip roller both with regard to the material and to the geometry of the circumferential surface. Guaraldi at col. 3, lines 52 to 54 (emphasis added by applicants). One having ordinary skill in the art knows that conventional slip rollers are embodied with

a smooth circumferential surface, in other words, an unstructured circumferential surface. Accordingly, Guaraldi actually teaches away from providing the surface structure of the roller according to claims 1 and 10 of the instant application.

The inventors of the instant application were the first to have the idea to provide the circumferential surface of such a slip roller with a structure in order to achieve certain advantages set forth, for example, on page 5, lines 15 to 22, and page 15, line 13, to page 16, line 9, of the specification of the instant application.

The shear forces in the prior art slip rollers and in Guaraldi's slip roller 16 are greatly dependent on the set pressure in the slip gap. See page 5, lines 9 to 11, of the specification of the instant application. Even though it was already known to Guaraldi that the amount of the damping solution transferred to the slip roller 16 can be changed by a variation of the roller compression (see Guaraldi at col. 5, lines 5 to 15), Guaraldi did not yet recognize that with a suitable structure of the circumferential surface of the roller compression quasi-independent shear forces can be achieved, as in the case of the invention of the instant application. See page 5, lines 18 to 20, of the specification of the instant application.

Clearly, Guaraldi does not show a roller as recited in claims 1 or 10 of the instant application.

On page 3 of the above-identified Office action, claims 4 and 6 to 9 have been rejected as being obvious over Guaraldi in view of Shiraki et al. (U.S. 6,196,958; hereinafter "Shiraki") under 35 U.S.C. § 103.

It is respectfully noted that Shiraki pertains to a technical area entirely different from the technical area of Guaraldi. And, more importantly, to a technical area entirely different from the technical area of the invention of the instant application.

Specifically, Shiraki relates to toner supply (in other words, a powder supply) and Guaraldi relates to fluid flow. One having ordinary skill in the art would know that the type of substance to be transported on a roller determines the embodiment of the roller surface. Furthermore, such a person of skill in the art would know that a powder and a liquid differ in their basic physical characteristics, which are essential for proper roller processing. For example, the topic of shear forces -- which was discussed several times in the specification of the instant application and is a central thread of the instant application -- is only important with

regard to liquids (for example, a printing ink, a damping solution, and an emulsion). This basic characteristic is entirely unimportant and contrary to a roller for conveying a powder such as toner. Therefore, starting from Guaraldi, one having ordinary skill in the art would not be directed towards a toner roller and use a teaching such as found in Shiraki, which teaching pertains to the processing of a powder, when attempting to solve problems having to do with liquid shear forces. Even if it is assumed, in an opposite analysis, that one having ordinary skill in the art would start with Shiraki, that person would know that the surface structuring of the "toner supply roller 26" in Shiraki is only designed for a powder (see Shiraki at col. 6, line 65 ("powdered toner 24")) and is not designed for a liquid, especially because powder and liquid are entirely different in the characteristics relevant for surface structures.

A critical step in analyzing the patentability of claims pursuant to 35 U.S.C. § 103 is casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field. See In re Dembiczak, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). Close adherence to this methodology is especially important in cases where the very ease with which the invention can be understood may prompt one "to fall victim to the insidious

effect of a hindsight syndrome wherein that which only the invention taught is used against its teacher." Id. (quoting W.L. Gore & Assocs. Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 313 (Fed. Cir. 1983)).

Most if not all inventions arise from a combination of old elements. See In re Rouffet, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457 (Fed. Cir. 1998). Thus, every element of a claimed invention may often be found in the prior art. See id. However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. See id. Rather, to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion, or teaching of the desirability of making the specific combination that was made by the appellant. See In re Dance, 160 F.3d 1339, 1343, 48 USPQ2d 163.5, 1637 (Fed. Cir. 1998); In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984).

The motivation, suggestion, or teaching may come explicitly from statements in the prior art, the knowledge of one of ordinary skill in the art, or, in some cases the nature of the problem to be solved. See Dembiczak, 175 F.3d at 999, 50 USPQ2d at 1617. In addition, the teaching, motivation, or suggestion may be implicit from the prior art as a whole,

rather than expressly stated in the references. See WMS Gaming, Inc. v. International Game Tech., 184 F.3d 1339, 1355, 51 USPQ2d 1385, 1397 (Fed. Cir. 1999). The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art. See In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981) (and cases cited therein). Whether an examiner relies on an express or an implicit showing, the Examiner must provide particular findings related thereto. See Dembiczak, 175 F.3d at 999, 50 USPQ2d at 1617. Broad conclusory statements standing alone are not "evidence." Id. When an examiner relies on general knowledge to negate patentability, that knowledge must be articulated and placed on the record. See In re Lee, 277 F.3d 1338, 1342-45, 61 USPQ2d 1430, 1433-35 (Fed. Cir. 2002).

Upon evaluation of the Office action, it is respectfully believed that the evidence adduced is insufficient to establish a *prima facie* case of obviousness with respect to the claims.

Applicants respectfully believe that any teaching, suggestion, or incentive possibly derived from the prior art is only present with hindsight judgment in view of the instant application. "It is impermissible, however, simply to engage

in a hindsight reconstruction of the claimed invention, using the applicant's structure as a template and selecting elements from references to fill the gaps. . . . The references **themselves** must provide some teaching whereby the applicant's combination would have been obvious." In re Gorman, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991) (emphasis added). Here, no such teaching is present in either Guaraldi or Shiraki.

It is accordingly believed to be clear that none of the references, whether taken alone or in any combination, either show or suggest the features of claims 1 or 10. Claims 1 and 10 are, therefore, believed to be patentable over the art. The dependent claims are believed to be patentable as well because they all are ultimately dependent on claim 10.

Insofar as claim 5 is ultimately dependent upon claim 10, and due to the fact that claim 10 is believed to be allowable, the rejection of this dependent claim on page 5 of the above-identified Office action is believed to be moot. The rejection is also improper for all of the reasons set forth above.

Claims 11 to 14 have also been added, which are dependent upon claim 10. Support for these claims may be found, for example, on page 5, lines 4 to 13, page 9, lines 20 to 26, page 13,

line 25., to page 14, line 8, of the specification of the instant application.

In view of the foregoing, reconsideration and allowance of claims 1 to 14 are solicited.

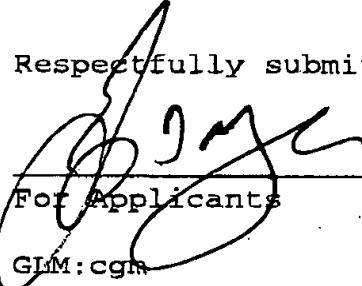
In the event the Examiner should still find any of the claims to be unpatentable, counsel would appreciate receiving a telephone call so that, if possible, patentable language can be worked out.

In the alternative, the undersigned counsel will be at the Patent Office during the second week of October. If the Examiner is amenable, it is respectfully requested for the Examiner to call the undersigned so that an interview can be scheduled.

Petition for extension is herewith made. The extension fee for response within a period of one (1) month pursuant to Section 1.136(a) in the amount of \$110.00 in accordance with Section 1.17 is enclosed herewith.

Please charge any other fees that might be due with respect to Sections 1.16 and 1.17 to the Deposit Account of Lerner and Greenberg, P.A., No. 12-1099.

Respectfully submitted,

  
For Applicants

GLM:cgn

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September 9, 2002

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Version of Claims With Markings to Show Changes Made:

Claim 10 (amended). A printing machine comprising at least one roller with a circumferential surface provided with a surface structure and formed of a nonmetallic material, said circumferential surface carrying a liquid, and said roller being selected from the group of rollers consisting of a slip roller and a vibrator roller.